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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,532	02/05/2004	Yingqing Lawrence Cui	08226/0200355-US0	5401

38880 7590 12/11/2006

DARBY & DARBY P.C.
P.O. BOX 5257
NEW YORK, NY 10150-6257

EXAMINER

KIM, WESLEY LEO

ART UNIT PAPER NUMBER

2617

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,532

Applicant(s)

CUI ET AL.

Examiner

Wesley L. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/06 has been entered.

Response to Amendment

This Office Action is in response to Amendment filed on 10/26/06.

Claims 1, 11, 16-17, 19-22, 30, and 40 are amended.

Claims 1-43 are pending in the current Office Action.

Response to Arguments

Applicant's arguments filed 10/26/06 have been fully considered but they are not persuasive.

- Applicant argues that Buckley does not format the first message to be readable by a mobile browser and sending the formatted first message towards the mobile browser.

The examiner respectfully disagrees. Formatting the first message to be readable by a mobile browser (Par.30 and Par.33; 9-14 and Fig.5C, HTTP is used to send the message to the mobile browser, where the mobile browser reads the data and then converts the data, i.e. image, to be displayed. The

message is HTTP formatted and is readable by the mobile browser, which is why the mobile browser can convert the data message file into a viewable picture to be displayed on the screen); and sending the formatted first message towards the mobile browser (Par.33;16-20 and Fig.5D, step 217, the message is read by the wireless device and the data is converted into an image).

- Applicant argues that Buckley does not transmit the first message to the destination wireless device and transmits a fourth message that is not the first message nor includes the first message.

The examiner respectfully disagrees. According to the examiners interpretation a data file is a first message (Par.29;15-17, the data i.e. first message is stored at a URL). The first message is transmitted to the mobile station (Par.33;11-14, the data stored, i.e. first message, is transmitted to the mobile station). The first message may have been sent to the mobile station over a fourth message, as the applicant has put it, however the first message has been transmitted to the mobile station and therefore Buckley anticipates the limitations as they are claimed.

- Applicant argues that Buckley does not teach the data file as being HTTP formatted and since the data file is formatted by the destination device after receipt, it cannot be implicit that the data file is converted prior to sending.

The examiner respectfully disagrees. The Buckley reference clearly teaches that the data stored, i.e. first message, is transmitted via HTTP (Par.33;11-14, so it is inherent that the data is HTTP formatted) and then the

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wireless device receives this data and converts that data message file, i.e. first message, to a picture which is viewable on the screen. For the wireless device to be able to convert the received first message, the first message must be readable, so it is inherent that the first message was formatted in such a way that the mobile browser is able to read the data and convert it into a viewable image.

- Applicant argues that the Buckley reference does not teach "receiving an alert indicating a first message is available for the mobile device".

The examiner respectfully disagrees. See rejection of claim 1 regarding this newly added limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 6-7, 9, 16-18, 20, 22-26, 28-30, 31-32, and 40-41 are rejected under 2003/0139193 to Buckley.

Regarding Claims 1, 16, 23, 29, 34, and 40, Buckley teaches managing a communication with a mobile device over a network (Fig.1), comprising: receiving an alert indicating a first message (i.e. data stored at a URL is the first message) is available for the mobile device (Par.29;12-17, a generation of a message which

indicates that data stored at the URL is available for the destination device is an alert indicating that a first message is available); sending a second message (Fig.5B;216) to the mobile device; wherein the second message includes a message hook (Par.33;3-5); employing the message hook to access the first message (Par.33, the URL is used to access the stored data); formatting the first message to be readable by a mobile browser (Par.33; 9-14 and Fig.5C, HTTP is used to send the message to the mobile browser, where the mobile browser reads the data and then converts the data, i.e. image, to be displayed. The message is HTTP formatted and is readable by the mobile browser); and sending the formatted first message towards the mobile browser (Par.33;16-20 and Fig.5D, step 217, the message is read by the wireless device and the data is converted into an image).

With further regards to Claim 23, Buckley teaches a transcoder that is configured to perform actions (Par.29, this is inherent based on the hub performing all of the claimed limitations of claim 1).

Regarding Claims 2, 17, and 28, Buckley teaches all the limitations as recited in claims 1, 16, and 23, and Buckley further teaches formatting the first/second message further comprises formatting the message using at least one of a HDML, WMLscript, and Javascript. (Par.26 and Par.33, for example, if a wireless phone is originating or receiving the data message over the internet, it is inherent that HTML, HDML, or WMLscript would have to be used to format the data message, where HTML, HDML, and WML are all scripts for displaying information

on a computer screen, but HDML and WML are modified versions of HTML which allow displaying the information on small mobile phone displays).

Regarding Claim 6, Buckley teaches all the limitations as recited in claim 1, and Buckley further teaches receiving the first message further comprises receiving at least one of a user account identifier, and a universal message identifier associated with the first message (Par. 29, wireless device's identifier).

Regarding Claims 7, 18, 25, 31, and 41, Buckley teaches all the limitations as recited in claims 1, 16, 23, 29, and 40, and Buckley further teaches the message hook further comprises a URL (Par. 29).

Regarding Claims 9, 20, 26, and 32, Buckley teaches all the limitations as recited in claims 1, 16, 23, and 29, and Buckley further teaches the first/second message further comprises at least one of an SMS message, and an MMS message (Par.29).

Regarding Claims 22 and 24, Buckley teaches all the limitations as recited in claims 16 and 23, and Buckley further teaches the first message comprises a graphics file (Par.27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 3-4, 8, 10, 19, 21, 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Archer (U.S. Patent 6,122,485).

Regarding Claim 3, Buckley teaches all the limitations as recited in claim 1, however Buckley **does not expressly teach** including wherein sending the second message further comprises: associating a message index with the first message; associating the message index with the second message; and sending the second message including the associated message index to the mobile device, wherein the message index is usable to locate the first message.

However, Buckley does teach that the first and second message are linked together, where the second message is used to access the first message.

Archer teaches a general method and system for messaging in which messages are indexed to a specific caller in order for that caller to later confirm receipt of a sent message (Fig.2, and Col.5,42-55). In addition, Archer teaches a method of finding a given message by searching an index table related to the record's position in a sequentially numbered list of records (Col.7;1-10).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to include a message index, mapping the first and second messages, because indexing messages is well known as taught by Archer and by indexing the first and second messages, a single index could be used to identify the location of the first message and forwarded to the mobile device to more easily indicate the location of the first message.

Regarding Claim 4, Buckley and Archer teach all the limitations as recited in claim 4, and Archer further teaches including wherein the message index with the first message further comprises employing a one way hash (Col.6:59-65).

Regarding Claims 8, 10, 19, 21, 27, and 33, Buckley and Archer teach all the limitations as recited in claims 1, 16, 23, and 29, and the combination further teaches the first message further comprises a message index associated with the message (see claim 3), wherein the message index is employable to locate the message (see claim 3) and the message hook further comprises a message index (this would have been obvious to one of ordinary skill in the art at the time the invention was made because it is an additional indication of the location of the message) associated with the message, and a URL (Buckley, paragraphs 29 and 33).

3. Claims 5, 11, 14, 30, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bern et al (U.S. Patent 6,898,422).

Regarding Claim 34, Buckley teaches all the elements of independent claim 34, including: A system for communicating messages to a mobile device over a network (see Claim 1) comprising; a mobile messaging service (Par.29, element 10), coupled to the mobile device (Fig.1), that is configured to perform actions, including: receiving the alert (Par.29); associating a message hook with the first message (Par.29); sending a second message to the mobile device, wherein the second message includes the message hook (Par.29); a web service (Fig.1, elements 24 and 22 include the internet and Fig.2, which shows element 10, including HTTP

servers 114 and 112), coupled to the mobile message service, that is configured to perform actions, including: receiving a response to the second message from the mobile device, wherein the response employs the message hook (Par.33); retrieving the first message (Par.33); formatting the first message to be readable by a mobile browser (Par.33); and sending the formatted first message towards the mobile browser (Par.33), however Buckley **does not explicitly teach** a mail transfer service configured to receive a first message and to provide an alert indicating receipt of the first message, and the mail transfer service coupled to the mobile messaging service and the mobile device, where the mobile message service receives the alert from the mail transfer service.

Buckley does teach the desire to send a "data file" from one wireless device to another wireless device that may represent a "digital image, sound, program instructions, ring tone, or other digital data" and that in the hub 10, the HTTP servers communicate internet protocol messages with the internet (Par.5 and Par.23).

In addition, Bern teaches a mail transfer service (Fig.1, element 150), which receives email messages, stores them and sends SMS notifications to mobile stations (Col.6:9-41). Bern also teaches the use of a message hook, which is a job identifier that uniquely identifies each email (Col.6:62-66).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Buckley to include a mail transfer service as taught by Bern, including a mail transfer service that receives a first message and provides an alert, the mail service being coupled to a mobile messaging service and

a mobile device, because the mail transfer service would add additional functionality to the system of Buckley and because Buckley suggests/recognizes that the "data files" may be sent via emails, as they are received at HUP servers. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to understand that the message hook taught by Buckley (URL, Par.29 and 33) could also include the unique job identifier taught by Bern (column 6, lines 62 to 66).

Regarding Claim 5, the rejection of claim 34 is hereby incorporated. Buckley in view of Bern teach all the steps of dependent claim 5, including wherein the first message is stored in a mail farm (Bern, Col.6:62-67).

Regarding Claim 11, the rejection of claim 34 is hereby incorporated. Buckley in view of Bern teach all the steps of dependent claim 11, including receiving the first message further comprises: receiving the first message by a mail transfer service (see claim 34); storing the first message at a mail farm by the mail transfer service (Bern, Col.6:62-67, see claim 5). However, Buckley **does not explicitly teach** associating a universal message identifier with the location of the stored first message.

But, Bern teaches assigning a 'job identifier' to each email received (Col.6:62-66).

Therefore, one of ordinary skill in the art at the time the invention was made would have included a job identifier (universal message identifier) as taught by Bern

in the system/method of Buckley because it further identified and allowed for quick recall of the stored message (Bern, Col.3;30-39).

Regarding Claims 14 and 30, Buckley in view of Bern teaches all the steps/elements of dependent claims 14 and 30, including wherein the first message is an email message (Bern, Col.6;62-66).

Regarding Claim 35, Buckley in view of Bern teaches all the elements of dependent claim 35, including wherein formatting the first message further comprises formatting the message using at least one of a HDML, WMLscript, and Javascript. (Buckley, Par.26 and Par.33, for example, if a wireless phone is originating or receiving the data message over the internet, it is inherent that HTML, HDML, or WMLscript would have to be used to format the data message, where HTML, HDML, and WML are all scripts for displaying information on a computer screen, but HDML and WML are modified versions of HTML which allow displaying the information on small mobile phone displays).

Regarding Claim 36, Buckley in view of Bern teaches all the elements of dependent claim 36, including the message hook further comprising a URL (Buckley, Par.29).

4. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Corrigan et al (WO 03/030474 A2).

Regarding Claim 12, Buckley does not explicitly teach all the steps of dependent claim 12, however, Corrigan does teach all of the additional steps, including logging into an account at a server through the mobile device (page 8,

lines 24 to 27); forwarding a device identifier associated with the mobile device to the server (page 8, lines 24 to 27), this would be inherent in the HTTP GET message; receiving at the mobile device a confirmation URL from the server (page 8, lines 10 to 15); responding to the confirmation URL (page 8, lines 24 to 27); and if the mobile device is confirmed, registering the mobile device to receive the formatted first message (page 8, line 29 to page 30, line 6).

Therefore, one of ordinary skill in the art at the time the invention was made would have understood that an authentication system, like the one taught by Corrigan could be used to ensure that the message receiver was in fact the correct receiver (Corrigan, page 5, lines 15 to 25).

Regarding Claim 13, Buckley in view of Corrigan teach all the steps of dependent claim 13, including wherein registering the mobile device further comprises associating the device identifier with the account (Corrigan, page 6, line 4).

5. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bern as applied to claim 34 above, and in further view of Archer (U.S. Patent 6,122,485).

Regarding Claim 37, The rejections of claims 3 to 4, 8, 10, 19, 21, 27, and 33 are hereby incorporated. Buckley in view of Bern and further in view of Archer teaches all the elements of dependent claim 37, including wherein the message hook further comprises a message index (see claim 3).

Regarding Claim 38, Buckley in view of Bern and in further view of Archer teaches all the elements of dependent claim 38, including wherein the message index further comprises a mapping between a universal message identifier and a device identifier. (Bern, Col.6;62-Col.7;6).

Regarding Claim 39, Buckley in view of Bern and in further view of Archer teaches all the elements of dependent claim 39, including wherein retrieving the first message further comprises: determining a message index associated with the message hook (Archer, column 7, Page 13 lines 20 to 32) and a device identifier (Id.); employing the message index to access a universal message identifier (Bern, column 6, lines 62 to 66, job identifier), and employing the universal message identifier to retrieve the first message (Bern, column 6, line 62 to column 7, line 10).

One of ordinary skill in the art at the time the invention was made would have understood that any number of elements could be indexed, such as the messages to each other, the job identifier taught in Bern, a mobile's MSISDN taught by both Buckley and Bern, etc. because the goal with indexing as taught by Archer, is to simplify the identification and look-up of a given record (as in page confirmation) (Archer, column 3, lines 17 to 26).

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bern as applied to claim 1 above, and further in view of Bengtsson et al (U.S. Patent 6,865,191).

Regarding Claim 15, Buckley in view of Bern does not explicitly teach all the steps of dependent claim 15, including wherein the first message further comprises

an email message and an attachment to the email message. However, Bengtsson teaches a method of sending a SMS message indicating that there is an attachment available and being stored on an attachment server, whose URL is included in the SMS message (Column 5, lines 4-36) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Buckley in view of Bern to include the functionality of further including information regarding email attachments, as taught by Bengtsson because this would allow additional types of data files to be messaged/stored.

7. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Bachner, III et al (U.S. Pub. 2005/0037787 A1).

Regarding Claim 42, Buckley teaches all the limitations as recited in Claim 1, however Buckley **is silent on** determining one of a plurality of servers to store the first message based at least in part on an end-user account identifier, a universal message identifier, or a device identifier.

Bachner teaches determining one of a plurality of servers (i.e. a portable server) to store a message based at least in part on an end-user account identifier (Par.407; the email address is the end-user account identifier).

To one of ordinary skill in the art, it would have been obvious to modify Buckley with Bachner such that, one of a plurality of servers is determined to store the first message based at least in part on an end-user account identifier, a universal message identifier, or a device identifier, to provide a method where the message is

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stored in location where the users experience the least amount of delays, difficulties, and problems of the wireless connection.

8. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Wells et al (U.S. Patent 6078820).

Regarding Claim 43, Buckley teaches all the limitations as recited in claim 1, however Buckley **is silent on** a program enabled to be executed by the mobile device to request access to the first message.

Wells teaches that it is well known in the art to utilize an internet browser program to access information on the internet (Col.7;8-10). The hook included in the second message is a URL and therefore to obtain the first message, a internet browser program must be used to access the first message.

To one of ordinary skill in the art, it would have been obvious to modify Buckley with Wells at the time of the invention such that a program executed by the mobile device enables access to the first message, to provide a method where a lengthy message may be retrieved by the user of a mobile device, over the internet, via notification from a short SMS message.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley L. Kim whose telephone number is 571-272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WLK



GEORGE ENG
SUPERVISORY PATENT EXAMINER